

REMARKS/ARGUMENTS

Favorable reconsideration of this Application, in light of the following discussion, is respectfully requested.

This Request for Reconsideration is in response to the Final Office Action mailed on September 9, 2005. Claims 1-13 are pending in the Application and stand rejected.

In the outstanding Final Office Action, Claims 1-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Komanduri et al. (U.S. Patent No. 4,584,649, hereinafter "Komanduri") in view of Puri (U.S. Patent No. 6,064,982).

Applicants first traverse the fact that the outstanding Office Action was made final even though the invention as disclosed and claimed was not thoroughly searched in the first action and no specific reference was fully applied on the merits of the claimed subject matter. As noted in the Office Action of March 15, 2005, "no art rejection has been applied due to the inconsistent usage of tooling sheet and the lack of nexus of the limitations as disclosed in the instant specification and claim language." However, as explained during the interview of April 19, 2005, the definition of the expression "tooling sheets" was enclosed in Applicants' specification as noted on page 1, lines 5-8. Furthermore, although the specification and the claims were amended to address informal issues related to an objection to Applicants' specification and a rejection under 35 U.S.C. § 112, no arguments were submitted about the merits of the rejection under 35 U.S.C. § 102 because, as noted in the summary of the interview of last April, "the currently cited reference of prior art does not provide sufficient basis for rejection of the instant claims; thus further search and consideration is necessary."

MPEP § 706.07 states:

"Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied;

and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, *or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter*, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.” (Emphasis added).

In addition, since the new grounds of rejection introduced in the outstanding Office Action was neither necessitated by Applicants’ amendment of the claims nor based on information submitted in an IDS, Applicants respectfully submit that the outstanding Final Rejection is not proper on a second action.¹ Accordingly, it is respectfully requested that the finality of the outstanding Office Action be withdrawn.

As to the rejection of Claims 1-13 under 35 U.S.C. § 103(a), Applicants respectfully submit that Komanduri and Puri, neither individually nor in any combination, support a *prima facie* case of obviousness of the invention recited in Claims 1, 7, and 8. This is so because, there is no motivation to combine the references because Puri is nonanalogous to Applicants’ invention.

As explained during the personal interview, the present invention relates to the preparation of tooling sheets, which involve the generation of recommended cutting conditions for a cutting tool, including a tool body, insert, and the material of the insert. Conventional practice has been to examine catalogs supplied by manufacturers, or to search cutting tool databases, and to select an optimum combination on the basis of experience and skill of the designer in consideration of cutting conditions, thus resulting on an unreliable

¹ Furthermore, Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). MPEP § 106.07(a).

method of tool selection.² Therefore, it is one of the objects of the instant invention to provide a system and method for the preparation of tooling sheets, and a program for the preparation of tooling sheets containing recommended cutting conditions that take into account a combination of a tool body, an insert, and a material of the insert. In addition, the recommended cutting conditions for selected tools may also be modified as desired in response to use conditions.³

The outstanding Office Action acknowledges that Komanduri “fails to teach the use of databases and the preparation of a tool sheet as per the limitations of the instant invention.” Puri is cited as allegedly remedying the acknowledged deficiencies of Komanduri. However, Puri is a nonanalogous piece of art; as such, there is not motivation to combine the cited references.

As noted by the Court of Appeals for the Federal Circuit in *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992), the test for nonanalogous art is two-pronged. First, the cited reference must be of a different field of endeavor than that of the Applicant’s invention. Second, the cited reference must not be directed to the same problem as the Applicant’s invention. Both prongs are met here.

Puri relates to a tool that assists company representatives in configuring a product to meet a customer’s needs (Puri, col. 1, lines 5-8). As explained, the instant invention relates to the preparation of tooling sheets. Thus Puri is of a different field of endeavor than Applicants’ field.

Secondly, Applicants’ invention is concerned with the preparation of tooling sheets, which involve the generation of recommended cutting conditions for a cutting tool, including a tool body, insert, and the material of the insert. Specific applications mentioned in Puri

² See, Specification, page 1, third paragraph.

³ See, Specification, page 2, lines 1-6.

involve the assistance of sales and marketing personnel to keep their customer's abreast of current company product offerings, configurations, options, and pricing. Company policies, security requirements, acceptable bandwidth, as well as more typical factors such as physical plant and number of workstations are other applications discussed (*Id.*, lines 11-28).

Therefore, Puri is not directed to same problem as the Applicants' invention. Since both prongs of *Oetiker* are met, Puri should be considered nonanalogous.

The fact "that a prior art device could be modified to produce the claimed device does not justify an obviousness rejection unless the prior art suggested the modifications desirability." *In re Gordon*, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Neither Komanduri nor Puri suggests the proposed combination.

The Office is kindly reminded that, in resolving the level of ordinary skill in the art, one "must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to [the PTO Office,] the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984). See also *Oetiker*, *supra*, disqualifying a reference that was not within the field of an applicant's endeavor and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem in one art, would reasonably be expected or motivated to look for a solution in an inapplicable art.

The presence or absence of a motivation to combine references is a question of fact,⁴ which should be evaluated under the substantial evidence standard as required by the

⁴ See, for example, *In re Dembiczak*, 175 F.3d 994, 1000 (Fed. Cir. 1999).

administrative Procedures Act.⁵ Substantial evidence is “such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.”⁶ Based on such a standard, the MPEP requires “[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. . . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings.”⁷ Applicants respectfully request that substantial evidence be provided for a motivation to combine the cited references or that the rejection be withdrawn. The alleged reason to combine the references is merely a statement of possibility⁸ that disregard what each reference teaches as a whole and not of a motivation to combine satisfying the strict fact-finding requirement just noted. In other words, the mere presence of a claimed feature in a secondary reference is insufficient to establish a motivation to incorporate that feature in the teachings of a primary reference.

Accordingly, Komanduri and Puri, neither individually nor in any combination, make obvious the invention recited in Claims 1, 7, and 8. Claims 2-6 and 9-13 should be allowed, among other reasons, as depending either directly or indirectly from Claims 1, 7, or 8, which should be allowed as just explained.

In addition, Claims 2-6 and 9-13 are further considered allowable as they recite other features of the invention that are not disclosed, taught, or suggested by the applied references when those features are considered within the context of the subject matter recited in

⁵ *Dickenson v. Zurko*, 119 S. Ct. 1816, 50 USPQ 2d 1930 (1999); *In re Gartside*, 203 F.3d 1305, 53 USPQ 2d 1769 (Fed. Cir. 2000).

⁶ *In re Gartside*, 203 F.3d 1305, at 1312 (Fed. Cir. 2000).

⁷ MPEP § 2144.08 III.

⁸ “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

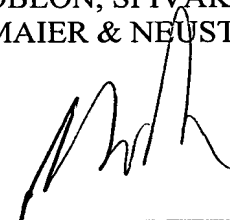
independent Claims 1, 7, and 8. For the foregoing remarks, Applicants respectfully request withdrawal of the rejection of Claims 1-13 under 35 U.S.C. § 103(a).

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-13 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Robert T. Pous
Registration No. 29,099
Attorneys of Record

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

GJM/RTP/MQM:fm
I:\ATTY\MQM\24'S\247925US\PROP AMD 12-9-05.DOC